

## Remarks

Claims 1 and 3-27 are pending in the application. Claim 2 has been cancelled, and Claim 27 has been added. The rejections of Claims 1 and 3-26 are respectfully traversed below.

### *A. Claims 1 and 3-26 are Not Unpatentable As the Office Action Has Not Made Out a Prima Facie Case of Obviousness*

The Examiner has the burden to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103(a). *See* MPEP 2142. To establish a prima facie case of obviousness, three basic criteria must be met. *See* MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See Id.* Indeed, the proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. *See* MPEP 2143.01. Second, there must be a reasonable expectation of success. *See* MPEP 2143. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *See Id.* (citing *In re Vaeck*, 947 F.2d 488, 20USPQ2d 1438 (Fed. Cir. 1991)).

#### *1. Claims 1, 3-7 and 11 are Patentable Over Schuette in View White*

Claims 1-7 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. Patent No. 2,998,655 to **White**. Claim 2 has been cancelled. The Office action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a handle as taught by **White** in conjunction with the device of **Schuette** for the purpose of easily manipulating the **Schuette** device.” In addition, the Office Action states it also would have been obvious “to use plural levels as taught by **White** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device in a plurality

of orientations. The Office Action further states that it would have been obvious “to use graduations as taught by **White** in conjunction with the **Schuette** device to permit a person to make measurements with the **Schuette** device.”

Claim 1 has been amended to additionally recite “a second level on the plate such that the plate is in a second preferred orientation for marking at least a portion of the geometric pattern on the substantially vertical surface when the second level indicates the plate is in a substantially level position.” Because remodel boxes always are oriented the same way on a wall, the remodel box installation tool described in **Schuette** always is used in a single, upright orientation. Therefore, **Schuette** actually teaches away from a marking tool or template that includes two levels for positioning the tool in two different orientations. Accordingly, there is no suggestion in **Schuette** “to use plural levels as taught by **White** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device in a plurality of orientations.” Still further, the **Schuette** device requires no form of measurement to mark a remodel box opening on a wall. Accordingly, **Schuette** teaches away from using such a device for measurement, and there is no suggestion in **Schuette** to add graduations “to permit a person to make measurements with the **Schuette** device.” The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

## **2. Claims 8-10 and 22-26 are Patentable Over Schuette and White in View of Barr**

Claims 8-10 and 22-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** and **White** in view of U.S. Patent No. 6,226,882 to **Barr**. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use marking materials as taught by **Barr** in conjunction with the **Schuette** and **White** devices for the purpose of using the combined device to print patterns on a surface.”

Claims 8-10 depend from Claim 1 and include all the limitations thereof. Claims 8-10 and independent Claim 22 each require two separate levels for indicating two different orientations of the tool. As discussed above with respect to Claims 1, 3-7, and 11, the **Schuette** device is used in a single orientation, and teaches away from plural levels for indicating different tool orientations. Accordingly, the combination of **Schuette** and **White** is improper because there is no teaching or suggestion in the references for the proposed modification. Therefore, further modification of the improper combination of **Schuette** and **White** in view of **Barr** also is improper. Therefore, the rejection of claims 8-10 and 22 should be withdrawn.

Claims 23-26 each recite a method of painting that includes “painting a pattern on the substantially vertical surface using the marked shapes as a guide.” None of the cited references disclose such a painting step. **Barr** describes a marking tool for marking a sheet of material to facilitate cutting openings in the material, and does not disclose more. Therefore **Barr** does not disclose using marked shapes as a guide for painting a pattern on a surface as claimed, and the proposed combination does not include every element recited in the claims. Accordingly, the rejection of claims 23-26 is improper, and should be withdrawn.

### **3. Claim 12 is Patentable over Schuette and White in View of Johansen**

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** and **White** in view of U.S. Patent No. 5,864,959 to **Johansen** et al. The Office Action states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a concave surface as taught by **Johansen** in conjunction with the **Schuette** and **White** devices for the purpose of using the combined device to elevate the tool above a surface.”

Claim 12 depends from amended Claim 1, and therefore includes every limitation of Claim 1. As discussed above regarding Claim 1 et al., the **Schuette** device is used in a single orientation, and teaches away from plural levels for indicating different tool orientations. Accordingly, the combination of **Schuette** and **White** is improper because there is no teaching or suggestion in the references for the proposed modification. Therefore, further modification of the

improper combination of **Schuette** and **White** in view of **Johansen** also is improper. Therefore, the rejection of claim 12 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to the combination of **Schuette** and **White** in view of **Johansen**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

#### **4. Claims 13 and 14 are Patentable Over Schuette and White in View of Trane**

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** and **White** in view of U.S. Patent No. 1,614,812 to **Trane** et al. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the handle as taught by **Trane** in conjunction with the **Schuette** and **White** devices as an alternative means for holding the combined device.” The Applicant respectfully traverses this rejection.

Claims 13 and 14 depend from Claim 1, and therefore include every limitation of claim 1. As discussed above regarding Claim 1 et al., the **Schuette** device is used in a single orientation, and teaches away from plural levels for indicating different tool orientations. Accordingly, the combination of **Schuette** and **White** is improper because there is no teaching or suggestion in the references for the proposed modification. Therefore, further modification of the improper combination of **Schuette** and **White** in view of **Trane** also is improper. Therefore, the rejection of claims 13 and 14 should be withdrawn.

Furthermore, **Trane** does not disclose a handle “wherein the handle is a knob that is sized and configured for grasping in the palm of a person’s hand” as recited in claim 13, or such a knob that “includes at least one contoured recess sized and shaped to receive at least one finger of a

person's hand when the knob is grasped in the palm of the person's hand" as recited in claim 14. As described in the Applicant's specification:

A handle 16 is attached to the outer face 19 of the plate 12. In the embodiment shown, the handle 16 is a substantially round knob that is sized and configured to be gripped in the palm of a person's hand. The handle 16 may have any shape that is suitable for gripping in a person's hand or fingers. For example, the handle 16 may include a series of grooves or contours that cause the handle 16 to closely conform to a person's hand and/or fingers. (Page 4, lines 2-7)

Though the ruler shown in Figures 1-5 of **Trane** includes a "ring" (15), this ring (15) is described as a "pressure member" that is "operated by a finger of the operator." (Column 1, lines 41-48) Accordingly, the ring (15) described by **Trane** is not sized and shaped for grasping in the palm of a person's hand as claimed in Claims 13 and 14. Nor does the ring (15) of **Trane** include a contoured finger recess as recited in Claim 14. Accordingly, even if the proposed combination of **Schuette**, **White** and **Trane** is proper (which the Applicant does not hereby admit), the modification to the combination of **Schuette** and **White** does not include every element recited in claims 13 and 14, and the rejection of claims 13 and 14 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to the combination of **Schuette** and **White** in view of **Trane**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

#### **5. Claims 15 and 16 are Patentable over Schuette and White in View of Greer**

Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** and **White** in view of U.S. Patent No. 6,195,904 **Greer**. The Office Action states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to

use the plates as taught by Greer in conjunction with the **Schuette** and **White** devices for the purpose of rendering the combined device more versatile and adjustable.” The Applicant respectfully traverses this rejection.

Claim 15 and 16 depend from independent claim 1. As discussed above regarding Claim 1 et al., the **Schuette** device is used in a single orientation, and teaches away from plural levels for indicating different tool orientations. Accordingly, the combination of **Schuette** and **White** is improper because there is no teaching or suggestion in the references for the proposed modification. Therefore, further modification of the improper combination of **Schuette** and **White** in view of **Greer** also is improper. Therefore, the rejection of claims 13 and 14 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** and **White** in view of **Greer**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

**6. Claims 17 and 18 are Patentable over Schuette and White in View of Innis**

Claims 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** and **White** in view of U.S. Patent No. 6,349,823 to **Innis**. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the instructions as taught by **Greer** [sic] in conjunction with the **Schuette** and **White** devices to provide instructions for how to use the combined device.” The Applicant respectfully traverses this rejection.

Claims 17 and 18, as amended, recite first and second levels for orienting the tool in two different orientations. As discussed above regarding Claim 1 et al., the **Schuette** device is used in a single orientation, and teaches away from plural levels for indicating different tool

orientations. Accordingly, the combination of **Schuette** and **White** is improper because there is no teaching or suggestion in the references for the proposed modification. Therefore, further modification of the improper combination of **Schuette** and **White** in view of **Innis** also is improper. Therefore, the rejection of claims 17 and 18 should be withdrawn.

Furthermore, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** and **White** in view of **Innis**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

**7. Claims 19-21 are Patentable over Schuette, White, and Innis in View of Barr**

Claims 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette, White, and Innis** as applied in Claim 17, and further in view of **Barr**. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use marking materials as taught by **Barr** in conjunction with the **Schuette, White and Innis** devices for the purpose of using the combined device to print patterns on a surface.” The Applicant respectfully traverses this rejection.

Claims 19-21 depend from amended claim 17, and include every limitation of Claim 17. As discussed above regarding Claim 17, the proposed combination of **Schuette, White, and Innis** is improper because **Schuette** teaches away from using plural levels for indicating different tool orientations. Accordingly, further modification of the combination in view of **Barr** also is improper. Accordingly, the rejection should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette, White and Innis** in view of **Barr**. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

**B. Claim 27 is Patentable**

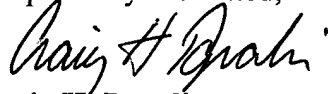
Claim 27 has been added. Claim 27 is directed to a stripe-marking tool like the embodiment described on pages 3-7 of the present specification and shown in Figures 1-5. Applicant believes that the claimed tool is novel and non-obvious over the prior art of record.



## Conclusion

Applicant believes this case is now in condition for the immediate allowance of Claims 1 and 2-27, and such action is respectfully requested. If any issue remains unresolved, however, Applicant's attorney welcomes the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,



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